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| 09/930,668 | 08/15/2001 | Judith Edmonds Starkey | 43107-218724 (05528-0110) | 3237 |
| 7590 | 07/11/2006 | | EXAMINER PORTER, RACHEL L | |
| John S. Pratt KILPATRICK STOCKTON LLP Suite 2800 1100 Peachtree Street Atlanta, GA 30309-4530 | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |
| DATE MAILED: 07/11/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,668

Applicant(s)

STARKEY ET AL

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/5/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 8/15/01. Claims 1-28 are pending. The IDS filed 10/5/2001 has been entered and considered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 9-13, and 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by “Indicare™- On-line Patient Assistance Program Website Users Manual.” (referred to hereinafter as Indicare)

[claim 1] Indicare discloses a method for identifying and applying for benefits for a patient comprising:

- obtaining initial patient information (i.e. application/enrollment forms (page 3, 7-10; 15-16).
- based upon initial patient information, making an initial determination as to whether it is likely that the benefits can be obtained(pg. 12, step 7)
- if the initial determination is that benefits are likely to be obtained, obtaining additional patient information, (page17—indicates whether pharmaceutical company is likely to decline/ require additional information.)
- providing a second indication that benefits are likely and submitting the application to the assistance program (page 14-15,17—i.e. acceptance or denial of a claim)

-

[claims 2-6] Indicare gathers information regarding the patient's age and medical condition; income and financial resources. (page 15, Questionnaire) The patient information is compared to well-established criteria (e.g. agency criteria) (page 17—Pharmaceutical company programs)

[claims 9-10] Indicare discloses a system/ method wherein additional patient information includes a discharge diagnosis (page 17-questionnaire). Indicare further discloses providing prompts to assist in the completion of an application (page 12 “patient data” and “physician data” section on screen shots)

[claim 11] Indicare discloses determining whether the patient is covered by an assistance program. (page 17 questionnaire—asks patient if they have health insurance)

[claim 12] Indicare discloses determining whether the patient is previously in the system with a claim/application for assistance. (page 13—allows users to start with old claim/application information.

[claim 13] Indicare discloses a method for accepting a referral for a patient, comprising:

- receiving a patient referral, the patient referral including initial patient information, (physician letters requesting assistance from the pharmaceutical company (i.e. donator) on behalf of the patient. (pages 3,5-6)

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- based upon initial patient information, making an initial determination as to whether it is likely that the benefits can be obtained(pg. 12, step 7)
- if the initial determination is that benefits are likely to be obtained, obtaining additional patient information, (page 17—indicates whether pharmaceutical company is likely to decline/ require additional information.)
- providing a second indication that benefits are likely and submitting the application to the assistance program (page 14-15, 17—i.e. acceptance or denial of a claim)

[claim 17] Indicare further discloses providing prompts to assist in the completion of an application (page 12 “patient data” and “physician data” section on screen shots)

[claim 18] Indicare discloses automatically completing a section of the application using the initial patient information. (pages 13-14)

[claims 19-21] Indicare discloses a method wherein the patient referral is received and accepted by a pharmaceutical company (i.e. an entity independent of the medical provider providing patient treatment)(page 17). Indicare further discloses that medical providers still cover some of the cost to accepted participants (page 3, last paragraph). Indicare further discloses submitting and monitoring the application to the assistance program (page 14-15, 17—i.e. acceptance or denial of a claim)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-8, 14-16, and 22- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Indicare™- On-line Patient Assistance Program Website Users Manual" in view of DeTore et al (USPN 4,975,840).

[claims 7-8] Indicare discloses the method/system of claim 1 as explained in the rejection of claim 1, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claims 14-16] Indicare discloses the method/system of claim 13 as explained in the rejection of claim 13, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine

probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claim 22,26] Indicare discloses a method for identifying and applying for benefits for a patient comprising:

- obtaining initial patient information (i.e. application/enrollment forms (page 3, 7-10; 15-16).
- based upon initial patient information, making an initial determination as to whether it is likely that the benefits can be obtained (pg. 12, step 7) by comparing initial patient information to well-established criteria (page 17—Pharmaceutical company programs)
- if the initial determination is that benefits are likely to be obtained, obtaining additional patient information, (page 17—indicates whether pharmaceutical company is likely to decline/ require additional information.)
- providing a second indication that benefits are likely and selecting the identified the assistance program (page 14-15, 17—i.e. acceptance or denial of a claim)

Indicare discloses the method/system of claim 22 as explained above, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claim 23] Indicare further discloses providing prompts to assist in the completion of an application (page 12 "patient data" and "physician data" section on screen shots)

[claims 24-25] Indicare gathers information regarding the patient's age and medical condition; income and financial resources. (page 15, Questionnaire). The patient information is compared to well-established criteria (e.g. agency criteria) (page 17—Pharmaceutical company programs)

[claim 27-28] Indicare discloses the method/system of claim 22, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. DeTore further discloses that the probability models used are based upon prior experience in obtaining similar coverage (i.e. benefits under

the second assistance program) (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Yaker et al (EP 0683465 A2) discloses a system for processing payment for healthcare services.
- Tung et al (USPN 5,803,498) teaches a system and method for providing free pharmaceutical products.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RP


C. LUKE GILLIGAN
PATENT EXAMINER